

REMARKS

Upon entry of this amendment, claims 1-10 are pending. The application relates to SODm therapy for treatment of inflammatory disease, which is beneficial for the treatment of certain inflammatory diseases. Claims 1-7 are to methods of such treatment, and claims 8-10 are to compounds for treating inflammatory disease.

Continuation-in-Part Rejection

The first objection is to claiming benefit of U.S. Application No. 09/634,152 which is now U.S. Patent No. 6,395,725. Applicants respectfully traverse this objection. Under the current rules relating to continuation-in-part application practice, "[a] continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and *adding matter not disclosed* in the said earlier nonprovisional application. MPEP § 201.08 *citing In re Klein*, 1930 C.D. 2, 393 O.G. 519 (Comm'r Pat. 1930) (emphasis in original).

Applicants have repeated a substantial portion of the earlier nonprovisional related to cyclooxygenase inhibition. Specifically, pages 3 through 9 of the specification relate reactive oxygen species (ROS) to the cyclooxygenase biochemical pathway which in turn is affected by the superoxide dismutase mimetics of the invention. This same disclosure of the invention is included in the U.S. Patent App. 09/634,152. Columns 1 through 3 of U.S. Patent No. 6,395,725, the issued patent based off U.S. Patent App. 09/634,152, contains substantially the same disclosure. Applicants respectfully submit that this substantial portion which is found in both U.S. Patent App. 09/634,152 and the present application properly satisfy the requirements to be considered a continuation-in-part application.

In addition, a continuation-in-part application shall be granted benefit of an earlier filing date if the application complies with three formal requirements:

- 1) the first application and the alleged continuing application were filed by the same inventor;
- 2) the alleged continuing application was filed before the patenting or abandonment of or termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application; and
- 3) the alleged continuing application contains or is amended to contain a specific reference to the earlier filed application.

See *In re Shaw*, 202 USPQ 285 (Dep. Ass't Comm'r Pat. 1978). Applicants satisfy all three of these requirements and should be entitled to the earliest filing date of the parent application.

Because we properly claim benefit to U.S. Application No. 09/634,152, the above Salvemini reference is not prior art which can be used against this application.

Rejections under 35 U.S.C. § 102(b)

Claims 1,2, 4-6 and 8-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Salvemini *et al.*, "A Nonpeptidyl Mimic of Superoxide Dismutase with Therapeutic Activity in Rats" Science, 286:304-306 (1999). ~~Because we properly claim benefit to U.S. Application No. 09/634,152, which was filed prior to the date of the above Salvemini reference, the reference is not prior art which can be cited against this application.~~

Rejections under 35 U.S.C. § 103(a)

Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being obvious over Salvemini *et al.*, "A Nonpeptidyl Mimic of Superoxide Dismutase with Therapeutic Activity in Rats" Science, 286:304-306 (1999). Because we properly claim benefit to U.S. Application No. 09/634,152, the above Salvemini reference is not prior art which can be used against this application.

Application No. 09/997,974
Amendment dated June 2, 2003
Reply to Office Action of December 6, 2002

CONCLUSION

Prompt and favorable consideration of this application is respectfully requested. Applicants enclose herewith a Letter confirming large entity and a Petition for a Three-Month Extension of Time Pursuant to 37 C.F.R. § 1.136 and PTO-2038 to cover the \$930.00 extension fee. Any deficiency or overpayment may be charged to Deposit Account No. 19-3140.

Respectfully submitted,



Kevin W. Buckley
Reg. No. 45,901
Customer No. 26263
(314) 259.5817

Express Mail Label No. EL 823777951 US

App. No. 09/997,974
RESPONSE TO OFFICE ACTION A UNDER 37 C.F.R. § 1.111